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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,709	01/18/2002	Joseph G. Buehl	43314/236952	5418

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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

SHELTON, BRIAN K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 04/22/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,709

Applicant(s)

BUEHL ET AL.

Examiner

Brian Shelton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 7, 9-12, and 15-18 is/are rejected.
7) ☒ Claim(s) 5, 6, 8, 13, 14 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to the Amendment filed January 18, 2004.
2. The Application has been examined. **Amended claims 1, 16, and 18, and original claims 2-15 and 17** are pending. The rejections cited are as stated below:

Response to Arguments

3. Applicant's arguments, see Applicants' Amendment filed January 18, 2004, with respect to adequate support of the claimed subject matter in the provisional application have been considered and are persuasive. Since the effective filing date established by the provisional application predates the Mao reference relied upon in the rejection of claims 1-18 in view of 35 U.S.C. 103, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 103, as demonstrated below.

Claim Objections

4. Claims 3-4 and 18 are objected to because of the following informalities:

In claim 3, line 2, "at least one particular service" should be ---at least one particular resource--- to be consistent with the amendment to claim 1.

In claim 4, line 2, "at least one particular service" should be ---at least one particular resource--- be consistent with the amendment to claim 1.

In claim 18, line 4, "in said cable system" should be ---in a cable system---.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-4, 7, 9-12 and 15-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over De Vos et al. (De Vos), U.S. Patent No. 6,128,650, in view of Fuhrman, U.S. Patent No. 5,745,837.

Regarding **independent claim 1**, De Vos discloses a method of implementing service in an ATM video on demand system (col. 3, lines 7-33), comprising:

- (a) generating at a set top box (set top box 40) application level data where said application level data represents a service offering (video on demand selection) comprising service data identifying particular resources associated with the service offering (menu of services provided by navigation device 30; see col. 13, lines 48-50), and routing data identifying the location of said particular resources in said ATM video on demand system (STB generation of request comprising address of Service Item Provider (SIP), see col. 13,

lines 63-66; see also Fig. 8 and col. 10, lines 54-61 describing navigation software downloaded to set top box 40 from navigation device 30 and identification data provided to set top box; col. 5, lines 31-38 [identification data, comprising address, supplied from end device (set top) to system manager]);

- (b) identifying at least one of said particular resources within said service offering (user selection of video on demand programming from STB display; col. 13, lines 48-63); and
- (c) generating a session request to receive the service offering, wherein said session request includes said routing data (col. 13, line 63-66 [set top box generates request to Service Item Provider (SIP) for video stream wherein the request comprises SIP address]).

De Vos fails to specifically disclose a cable system.

Fuhrman, in an analogous art, teaches an ATM network including video on demand services comprising a cable system (Fig. 27; col. 35, line 46 – col. 36, line 47) for the benefit of utilizing existing cable television distribution networks to provide point to point communication.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ATM video on demand system of De Vos to incorporate a cable system ATM distribution network, as taught by

Fuhrman, for the benefit of utilizing existing cable television distribution networks to provide point to point communication in a video on demand system.

The limitation of **claim 2** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 1. Specifically, De Vos discloses transmitting said session request to said service col. 13, line 63-66 [set top box generates request to Service Item Provider (SIP) for video stream, wherein the request comprises SIP address]). Fuhrman discloses the service (video on demand) located at the headend of the cable system (Fig. 27; col. 35, lines 57-64).

The limitation of **claim 3** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 2. Specifically, De Vos discloses parsing said session request at said service to extract the identified at least one particular service (col. 13, line 66 – col. 14, line 16).

The limitation of **claim 4** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 3. Specifically, De Vos discloses determining the location of the identified at least one particular resource (col. 14, lines 7-13).

Regarding **independent claim 7**, De Vos discloses a system for administering a session in an ATM video on demand system (col. 3, lines 7-33), comprising:

- (a) a service residing in said system (Service Item Provider 64 (SIP)); ;
- (b) at least one set-top box (set top box 40), wherein the at least one set-top box is in communication with said service and generates a request to the service (col. 13, lines 63-66 [set-top communicating with SIP and generating request]; see also col. 14, lines 5-7 [communication of VCR commands from set-top box to SIP]); and
- (c) wherein said request comprises routing information (SIP address) identifying the location of said service and session data (requested video stream) identifying a particular service requested (col. 13, line 63-66 [set top box generates request to Service Item Provider (SIP) for video stream wherein the request comprises SIP address]).

De Vos fails to disclose a cable system.

However, Fuhrman, in an analogous art, teaches a cable system comprising an ATM network including video on demand services (Fig. 27; col. 35, line 46 – col. 36, line 47) for the benefit utilizing existing cable television distribution networks to provide point to point communication

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ATM video on demand system of De Vos to incorporate a cable system ATM distribution network, as taught by

Fuhrman, for the benefit of utilizing existing cable television distribution networks to provide point to point communication in a video on demand system.

The limitation of **claim 9** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 7. Specifically, De Vos discloses at least one server (storage medium unit (SMU)) located at the headend of the ATM video on demand system and in communication with said service (col. 14, lines 7-13 [SIP establishing connection between set-top box and SMU]). Fuhrman teaches the ATM video on demand system comprising a cable system (Fig. 27; col. 35, lines 57-64).

The limitation of **claim 10** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 9. Specifically, De Vos discloses the at least one server (storage medium unit SMU 20) comprising a session manager (controller 26), and wherein the service (SIP) communicates with said session manager to identify the particular service requested (col. 5, line 66 – col. 6, line 4 [controller 26 (session manager) facilitated reproduction of selected video data]; see col. 14, lines 7-16, describing service (SIP) communication with server (SMU) in response to user program selection).

The limitation of **claim 11** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 9. Specifically, De Vos

discloses the at least one server comprising a session manager (controller 26), and wherein said session manager communicates with said ATM video on demand system to establish a communication path through which to implement said service (col. 9, lines 45-47 [virtual channel (video stream) to set top (end device) connection table]). Fuhrman teaches the ATM video on demand system comprising a cable system (Fig. 27; col. 35, lines 57-64).

The limitation of **claim 12** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 7. Specifically, De Vos discloses a session resource manager (navigation device 30), wherein the session resource manager identifies available resource of said ATM video on demand system (col. 10, lines 45-65). Fuhrman teaches the ATM video on demand system comprising a cable system (Fig. 27; col. 35, lines 57-64).

Regarding **independent claim 15**, De Vos discloses a method of fulfilling a session request in an ATM video on demand system comprising:

- (a) receiving a session request at a service (Service Item Provider SIP), wherein said session request identifies to location of said service (SIP) in said system and the generator (Set top box) of said session request (col. 13, line 63-66 [set top request addressed to SIP (service address) for transmission to set top at given public address (generator address)]);

- (b) parsing said session request to identify the at least one particular service identified within said session request (col. 14, lines 7-13);
and
- (c) forwarding said at least one particular service identified within said session request to said generator (col. 14, lines 13-16 [routing requested video to set top box]).

But De Vos fails to disclose a cable system. However, Fuhrman, in an analogous art, teaches a cable system comprising an ATM network including video on demand services (Fig. 27; col. 35, line 46 – col. 36, line 47) for the benefit of utilizing existing cable television distribution networks to provide point to point communication

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ATM video on demand system of De Vos to incorporate a cable system ATM distribution network, as taught by Fuhrman, for the benefit of utilizing existing cable television distribution networks to provide point to point communication in a video on demand system.

The limitation of **claim 16** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 15. Specifically, De Vos discloses indicating a MPEG program number associated with the one particular service in said cable system (col. 8, lines 24-29 [selected movie identification

number]; see col. 3, lines 39-45 [video data from storage medium unit SMU in MPEG format]).

The limitation of **claim 17** is encompassed by the teachings of De Vos in view of Fuhrman, as discussed above relative to claim 15. Specifically, De Vos discloses executing, at said service, an instruction to the determined location to forward said at least one particular service to said generator (col. 14, lines 7-16 [Service (SIP) locating requested programming at SMU and routing program to requesting set top]).

In **claim 18**, the element of a “generic session manager” is not accorded patentable weight because it merely recites the intended use of the session request and the body of the claim does not depend on the “generic session manager” for completeness. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding **claim 18**, De Vos discloses a session request generated within a set top box (set top box 40), comprising session data identifying a particular

service (col. 13, lines 63-66 [set-top communicating with SIP and generating request for user selected video stream (video on demand program)]) and routing data identifying the location of said service (col. 13, line 63-66 [set top box generates request to Service Item Provider (SIP) for video stream wherein the request comprises SIP address]). But De Vos fails to disclose a cable system.

However, Fuhrman, in an analogous art, teaches a cable system comprising an ATM network including video on demand services (Fig. 27; col. 35, line 46 – col. 36, line 47) for the benefit utilizing existing cable television distribution networks to provide point to point communication

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ATM video on demand system of De Vos to incorporate a cable system ATM distribution network, as taught by Fuhrman, for the benefit of utilizing existing cable television distribution networks to provide point to point communication in a video on demand system.

Allowable Subject Matter

7. Claims 5-6, 8, and 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

LaJoie et al. (LaJoie), U.S. Patent No. 5,850,218, disclose service requests generated by a set-top box in a cable system wherein the services are identified according to a URL scheme incorporating information about the format, physical location, logical location, and identity of the service requested (see col. 17, line 58 – col. 18, line 10).

Wellner, U.S. Patent No. 5,640,193, discloses service requests for video on demand programming generated at a set top box comprising a request initially directing the set-top (interface 15) to address a specific server and further requesting a particular MPEG program from the specified server wherein a barcode scanner is utilized to select VOD programming (col. 5, lines 28 – col. 6, line 3; see col. 4, lines 58-64).

Haeri et al. (Haeri), U.S. Patent No. 6,604,241, discloses generating a request for video programming in a computer system comprising a URL request identifying the server storing a desired program and a video source identifier (col. 3, line 30 – col. 4, line 6).

Billock et al. (Billock), U.S. Patent No. 6,314,575, discloses a video-on-demand service in a cable system wherein a user interface presents a list of available programming on a set top box and, upon selection of a particular title, the set top box transmits the program ID corresponding to the selected title to the headend where a program table residing at the headend is utilized to determine

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the location of the user's selected program (col. 17, lines 19-65; see col. 3, line 61 –col. 4, line 49).

Bigham et al. (Bigham), U.S. Patent No. 5,544,161, discloses an interactive cable television system comprising multiple video information providers wherein a user identifies a particular video information provider to a level 1 gateway residing at the cable system headend and the level 1 gateway facilitate the communication between the user (set top box) and the selected video information provider (col. 15, lines 25-65; col. 7, line 50 –col. 8, lines 43).

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Shelton whose telephone number is (703) 305-8714. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the primary examiner, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Brian Shelton
Examiner
Art Unit 2611

BS


CHRIS GRANT
PRIMARY EXAMINER